

In re application of MONBERG ET AL.
Serial No. 09/651,406

REMARKS

The Office action has rejected claims 1-29 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,930,474 to Dunworth et al ("Dunworth") and U.S. Patent 6,408,294 to Getchius et al ("Getchius"). Applicants respectfully traverse these rejections. In the following, applicants provide an overview of their invention and then discuss the differences with the prior art of record.

Applicants' technique is generally directed towards maintaining information in the form of location bindings for a merchant that identify one or more regions serviced by the merchant, beyond only that region in which the merchant has a physical presence. For example, instead of maintaining a single ZIP code that corresponds to the merchant's address, a number of ZIP codes that the merchant services may also be maintained in association with the merchant, so that the merchant will be identified in response to a search request external to the merchant's ZIP code, but in a ZIP code serviced by the merchant as identified by the location bindings. Other aspects of the present invention are directed towards submitting a query for a merchant in a designated region, and receiving a business listing identifying a merchant that is not in the designated region, along with an explanation (such as text or glyph based) as to why that merchant was identified, e.g., the merchant services the region even though the merchant does not have a physical location in the region. Note that the above

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description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

In contrast to the claims of the present invention, Dunworth teaches an on-line search of information based upon a geographic hierarchy. At specified levels of the geographic hierarchy, the user is presented with the option of accessing topically organized information from among several topic selections, wherein the topical information is customized for each geographic area to reflect topics indigenous to that area. For a selected topic within a geographical area, a local content database may be accessed to retrieve a URL for the topic and yellow pages may be accessed for retrieving a business location. The geographic areas can expand in a hierarchical manner, that is, an intermediate geographic area that includes a smaller geographic area can be searched, as can a larger geographic area that includes the intermediate geographic area (and thus the smaller geographic area). Dunworth, column 3, lines 46-54.

However, as acknowledged in the Office action, Dunworth fails to disclose the concept of maintaining location binding information that allows a business to be located when that business does not have a physical location within a geographic area specified in a request. Instead, to locate such a business, Dunworth teaches that the database needs to search an expanded area by having the user manually ascend in the hierarchy (Dunworth, column 9, lines 1-4) until the geographic area specified in the request is enlarged sufficiently to include the location of the business. To this extent, Dunworth teaches away from

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the present invention, in which the location bindings automatically extend the search region, in effect, beyond that actually specified.

Notwithstanding the fact that (in contrast to the present invention) Dunworth teaches manually expanding and contracting the geographic search area, which requires significant user interaction, (as opposed to providing some teaching or suggestion as to how a business can be located in a search when it does not physically reside within a specified geographic area), the Office action contends that Getchius, which teaches a virtual business that need not have a particular physical location within a specified geographic area, can somehow be combined with Dunworth to reach the claims of the present invention. Applicants strongly disagree with this contention. Specifically, Dunworth teaches away from such a combination by distinguishing his system from systems which have geographically differentiated listings for the same topic (such as job search databases which include information about jobs in different cities), since these listings are primarily related to the topic (e.g., jobs), not to the geographical area. (Column 5, lines 47-65).

By law, in order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re*

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Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). As discussed in greater detail below, the claims of the present invention are thus clearly patentable over the teachings of the cited and applied references as a matter of law.

Turning first to independent claim 1, applicants recite the limitations of maintaining location binding information associating a merchant with a plurality of listed regions, including at least one listed region in which the merchant provides service and in which the merchant does not include a physical location, receiving a request directed to a particular region, and searching the location binding information associated with the merchant to determine if the particular region matches at least one of the listed regions, and if so, returning information regarding the merchant.

Applicants' technique thus may maintain information in the form of location bindings for a merchant that identify one or more regions serviced by the merchant, beyond only that region in which the merchant has a physical presence. Instead of maintaining a single location binding such as a merchant's address, a number of location bindings for separate regions where the merchant may provide services may also be maintained in association with the merchant, so that the merchant will be identified in response to a search request external to a specific region.

Dunworth does not teach or suggest the limitation of maintaining location binding information associating a merchant with a plurality of listed regions, including at least one listed region in which the merchant provides service and in which the merchant does not include a physical location. The Office action acknowledges

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that Dunworth does not teach maintaining location binding information associating a merchant with at least one listed region in which the merchant provides service and in which the merchant does not include a physical location. Office action page 3, line 23. However, the Office action mistakenly contends that Dunworth teaches the limitation of maintaining location binding information associating a merchant with a plurality of listed regions including at least one listed region in which the merchant provides service. Nowhere does Dunworth teach maintaining location binding information associating a merchant with a plurality of listed regions. Rather Dunworth teaches maintaining an address entry in a local content database which associates a business service with an expandable geographical region, not a plurality of listed regions. The databases in Dunworth are organized in a hierarchy which descends from most universal to least universal as follows: the geographic areas are ordered first by designating all of the continents in the world; then by all of the countries in each continent; then by all state, provinces, or territories within each country; then by each region within a state, province, or territory; then by each city within a region; and, finally, by each point of interest within a city. Thus, by means of the geography database in Dunworth, a user may ascend or descend in the geographic hierarchy to the particular geographic area about which information is desired. (Column 8, lines 60-67 – Column 9, line 4.) In Dunworth, once a user has located the appropriate geographic area about which information is desired, the user then changes to topical references. The topics listed are for a single geographic area, since Dunworth does not allow geographically differentiated listings for the same topic or topics listed for a plurality of geographic regions.

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Instead, Dunworth teaches that topical searches are seamlessly merged with geographical searches so that the user is able to geographically pinpoint the location of the desired goods or services in which the user is interested. (Column 9, lines 9-54.) Nowhere does Dunworth teach location bindings associating a business service with a plurality of listed regions. To the contrary, Dunworth teaches away from geographically differentiated listings for the same business service.

Nor does Dunworth teach or suggest searching the location binding information associated with the merchant to determine if the particular region matches at least one of the listed regions, and if so, returning information regarding the merchant. The Office action cites column 2, lines 54 through column 3, line 14 of Dunworth as allegedly disclosing the limitation of searching the location binding information associated with the merchant. Dunworth does not disclose any such limitation, but instead this cited section of Dunworth provides a summary describing Dunworth's database as organized into a hierarchy of geographical areas and Dunworth's search engine as configured to select one of the hierarchy of geographical areas prior to selection of a topic so that the topics are searched within the selected geographical search area. Nowhere does Dunworth teach searching the location binding information associated with the merchant because Dunworth does not teach location bindings associating a business service with a plurality of listed regions. Rather Dunworth teaches maintaining an address entry in a local content database which associates a business service with an expandable geographical region, not a plurality of listed

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regions. Nor does Dunworth teach or suggest the limitation to determine if the particular region matches at least one of the listed regions, and if so, returning information regarding the merchant. The Office action cites column 15, lines 23-25 and column 16, lines 17-26 of Dunworth as allegedly disclosing this limitation. Dunworth does not disclose any such limitation, but instead this cited section of Dunworth describes the folder name parameter of a search command for searching the local content database for a local topic within a selected geographic region. In fact, Dunworth could not disclose such a limitation because Dunworth teaches away from geographically differentiated listings for the same business service.

Dunworth, whether considered alone or in any permissible combination with the prior art of record, fails to teach or suggest all of the claim limitations of claims 1. For at least these reasons, applicants submit that claim 1 is allowable over the cited and applied references.

Similarly, independent claims 8, 12, 15, 20, and 25 of the present invention recites the limitation of "location binding data representing a region in which the merchant provides service and in which the merchant does not include a physical location" or "the business listing being associated with a merchant that provides service to the region but does not have a physical location in the region" or "searching a database containing information associated with merchants located within the region and outside the region." Again, Dunworth does not disclose any such limitations. The Office action refers to some of the same sections of Dunworth cited as allegedly disclosing the limitations of claim 1.

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Applicants need not repeat the many significant differences between these claim limitations and Dunworth's database organized into a hierarchy of geographical areas as previously discussed above. Nowhere does Dunworth teach location binding data representing a region in which the merchant provides service and in which the merchant does not include a physical location because Dunworth does not teach location bindings associating a business service with listed regions. Nor does Dunworth teach a location binding representing a region in which the merchant does not include a physical location, as acknowledged by the Office action. Nowhere does Dunworth teach the limitation of a business listing being associated with a merchant that provides service to the region but does not have a physical location in the region, as acknowledged by the Office action. Nowhere does Dunworth teach the limitation of searching a database containing information associated with merchants located within the region and outside the region because Dunworth teaches a local database within a requested geographic region which may be accessed for retrieving a business location.

None of the sections of Dunworth cited as allegedly disclosing the limitations of claims 8, 12, 15, 20 and 25 disclose these limitations, nor could they, because Dunworth teaches away from geographically differentiated listings for the same business service. Dunworth, whether considered alone or in any permissible combination with the prior art of record, fails to teach or suggest all of the claim limitations of claims 8, 12, 15, 20 and 25. For at least these reasons, applicants submit that these claims are allowable over the cited and applied references.

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Regarding the dependent claims, applicants respectfully submit that dependent claims 2-7, 9-11, 13-14, 16-19, 21-24 and 26-29, by similar analysis, are not anticipated by Dunworth or Getchius, either together or alone. Each of the dependent claims 2-7, 9-11, 13-14, 16-19, 21-24 and 26-29 includes the limitations of independent claims 1, 8, 12, 15, 20 and 25, respectively. As discussed above, neither Dunworth nor Getchius disclose these limitations taken together or individually. In addition to the limitations noted above, each of these dependent claims includes additional patentable elements.

Moreover, the Office action does not provide proper motivation for modifying Dunworth and/or combining the references. By law, in order to support a § 103(a) rejection, there must be some teaching, suggestion, or motivation other than applicants' teachings for modifying a cited reference or combining references to achieve the claimed invention. The Office action does not indicate any suggestion or motivation in the prior art of record, either explicit or otherwise, for modifying Dunworth or combining Dunworth with other references in a manner that would achieve the claimed invention. Instead the Office action concludes that "it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al to include the merchant that does not include a physical location" in order to provide applicants' invention. Office action, page 4, lines 4-6. The Office action further concludes, "It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al by the teachings of Getchius et al, because associating which the merchant that does

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not include a physical location would enable the user to obtain information about a business or a merchant who provides goods or services to the area but does not have a physical presence in the region." Office action, page 4, lines 7-11. Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to modify or combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The alleged motivation was clearly based on applicants' teachings, and not on anything found in the prior art or otherwise motivated. Such wholly speculative allegations cannot reasonably be used to support these claim rejections, and applicants respectfully request withdrawal of the §103(a) rejections of the claims for at least this additional reason.

Furthermore, Dunworth teaches away from geographically differentiated listings for the same business service. Dunworth distinguishes his system from systems which have geographically differentiated listings for the same topic (such as job search databases which include information about jobs in different cities), since these listings are primarily related to the topic (e.g., jobs), not to the geographical area. (Column 5, lines 47-65). Consequently, Dunworth teaches away from allowing a user to submit a query for a merchant in a designated region, and receiving a business listing identifying a merchant that is not in the designated region. Rather, to locate a business outside of the selected region, Dunworth teaches that the database needs to search an expanded area by having the user manually ascend in the hierarchy (Dunworth, column 9, lines 1-4)

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until the geographic area specified in the request is enlarged sufficiently to include the location of the business. Dunworth explicitly teaches away from the present invention, in which the location bindings automatically extend the search region, in effect, beyond that actually specified. If prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Thus, the claims of the present invention are clearly patentable over the teachings of the cited and applied references as a matter of law.

For at least these additional reasons, applicants submit that the claims are patentable over the prior art of record, whether considered alone or in any permissible combination. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested, and timely allowance of this application is earnestly solicited.

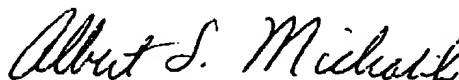
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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-29 of the present application are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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CERTIFICATE OF TRANSMISSION

I hereby certify that this Amendment, along with Transmittal and Petition for Extension of time are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: March 15, 2004


Albert S. Michalik

2590 Response after RCE